UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte LUKE DAVID JAGGER, ANTON CHRISTIAN ROTHWELL,
and WILLIAM R. DENNIS

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Appeal 2007-0331
Application 10/075,722
Technology Center 2100

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Decided: March 19, 2007

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Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and ANTON W. FETTING, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jagger, Rothwell, and Dennis (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 5 and 8 through 24, which are all of the claims pending in this application.

Appellants' invention relates to a method of identifying unsolicited electronic mail messages, commonly referred to as spam. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for identifying unsolicited electronic mail messages in a computer network, comprising:

receiving an electronic mail message;

removing non-static data including visible end-of-line characters and headers, from the electronic mail message;

generating a checksum based on data remaining within the electronic mail message;

comparing the generated checksum with a database containing checksums for previously identified unsolicited messages; and

identifying the electronic message as an unsolicited message if the generated checksum matches one of the database checksums;

wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Ralston   US 6,842,773 B1   Jan. 11, 2005
                                                          (Jan. 31, 2001)

Claims 1 through 3, 5, 8 through 15, 17, 18, 20, and 24 stand rejected under 35 U.S.C. § 102(b)[1] as being anticipated by Ralston.

Claims 4, 16, 19, and 21 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ralston.

We refer to the Examiner's Answer (mailed July 14, 2006) and to Appellants' Brief (filed April 20, 2006) and Reply Brief (filed September 14, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will affirm the anticipation rejection of claims 1 through 3, 5, 8 through 11, 13 through 15, 17, 18, 20, and 24 and the obviousness rejection of claims 19 and 22, but reverse the anticipation rejection of claim 12 and the obviousness rejection of claims 4, 16, 21, and 23.

OPINION

Appellants contend (Br. 9) that Ralston discloses stripping headers and hidden information to leave the visible text body of a message. Appellants further contend (Br. 9) that removing hidden information "*teaches away* from appellant's [sic] claimed 'removing <u>non-static</u> data including <u>visible</u> end-of-line characters,'" as recited in claim 1.

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[1] We note that the issue date of Ralston is after the filing date of the present application. Thus, part (b) of 35 U.S.C. § 102 is not applicable. However, the filing date of Ralston is prior to the filing date of the present application, which renders the patent prior art under 35 U.S.C. § 102(e). As the particular section of 35 U.S.C. § 102 has not been argued, we will treat the rejection as if under part (e).

Appellants disclose (Specification 10:2-5) that non-static material includes "headers, forwarding information, end-of-line characters, and forwarding characters." Appellants disclose (Specification 10:13-14) that non-static material may also include "a portion of the header such as a title." Ralston discloses (col. 8, ll. 9-18) dividing a message into a header and a body. The header includes routing information, a subject, the sending party, "and other information." The body of the message "is the information the unsolicited mailer **104** wishes the user **116** to read." Ralston shows in Figure 4 that the body of the message is the same kind of text that Appellants show in Figure 4 after the non-static material shown in Figure 3 has been removed. Thus, Ralston's header includes the header as defined by Appellants as well as forwarding information, and "other information."

Ralston discloses (col. 13, ll. 36-53) that information such as the header and hidden information in the body is removed to leave behind the visible body of the message. Since the information left by Ralston is the same as what Appellants disclose leaving behind, and since Ralston leaves open that "other information," other than that specifically listed, is to be removed, Ralston clearly removes end-of-line characters in addition to the header (as defined by Appellants). Further, end-of-line characters correspond to a portion of the header, not to the hidden information.

Appellants contend (Br. 10) that the Examiner has not shown that Ralston discloses removing non-static data "so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message," as claimed. However, Ralston states (col. 8, ll. 9-18) that routing information and the sending party "are often inaccurate in an attempt by the unsolicited mailer **104** to avoid blocking a mail system **112**

from blocking unsolicited messages from that source." Thus, Ralston clearly teaches removing the header because routing information is often made inaccurate by the sender (or forged by the spammer) to prevent identifying the message as unsolicited (or spam).

Thus, we have found Appellants' arguments to be unpersuasive. Accordingly, we will sustain the anticipation rejection of claims 1, 2, 8 through 10, 13, 14, 17, 18, and 20, all argued together as a first group. Also, for claim 24, Appellants rely (Br. 13) on the arguments against the rejection of claim 1, which arguments we found unpersuasive. Accordingly, we will affirm the anticipation rejection of claim 24. Similarly, for claims 19 and 22, Appellants rely (Br. 14) on the arguments against the rejection of claim 1, which arguments we found unpersuasive, without adding any additional arguments. Therefore, we will sustain the obviousness rejection of claims 19 and 22.

Appellants contend (Br. 11) that Ralston fails to disclose checksums for lines of data, as recited in claims 3 and 15, rather than for individual words or groups of characters. However, Ralston states (col. 13, ll. 52-53) that the checksum should be done on a group of three to ten words after small words are removed. A line of data is typically about 10 words. Therefore, Ralston discloses a checksum on lines of data, and we will sustain the anticipation rejection of claims 3 and 15.

Appellants contend (Br. 11) that Ralston fails to disclose deleting the unsolicited message, as recited in claim 5. However, claim 5 does not recite deleting an unsolicited message. Accordingly, the argument is not commensurate in scope with the claim. Thus, we will affirm the anticipation rejection of claim 5.

Appellants contend (Br. 12) that "the Examiner has failed to note any specific excerpt from Ralston that teaches" updating the database with new checksums, as recited in claim 11. Appellants admit that Ralston discloses "[i]f there is no match, the fingerprint for the message is added to the store(s) in step 682." Exemplars form fingerprints (see col. 10, ll. 61-62), and the fingerprints are used as the checksum (see col. 13, ll. 50-51). Checksums for which there is a match already exist in the database. Therefore, new checksums are those for which there is no match. The checksums for which there is no match are the ones which are added to the store (or database) in step 682. Therefore, we will sustain the rejection of claim 11.

Appellants contend (Br. 12) that the Examiner has failed to point to any particular teaching in Ralston that suggests the limitation of claim 12 that "the database is updated based on checksums generated from electronic messages received and identified as an unsolicited message." We agree. The database in Ralston gets updated with new checksums when there is no match. When there is no match the system sends the message to the user's inbox because it has been determined that the message is not unsolicited. Thus, the database is not updated based on new checksums from unsolicited messages. Accordingly, we cannot sustain the anticipation rejection of claim 12.

Appellants contend (Br. 13) that the Examiner "has argued that 'it is notoriously well known in the art to make comparisons between items in any order.'" Appellants contend (Br. 13-14) that merely being known is insufficient reason for rendering the claim language obvious. We agree. The Examiner has failed to provide an adequate reason to modify Ralston to

begin the checksums from the end of the message and work up to the
beginning of the message, and we find no suggestion in Ralston to do so.
Therefore, we will reverse the obviousness rejection of claims 4, 16, 21, and
23.

ORDER

The decision of the Examiner rejecting claims 1 through 3, 5, 8
through 11, 13 through 15, 17, 18, 20, and 24 under 35 U.S.C. § 102 and
claims 19 and 22 under 35 U.S.C. § 103 is affirmed. The decision of the
Examiner rejecting claim 12 under 35 U.S.C. § 102 and claims 4, 16, 21, and
23 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). *See* 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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